

MAR 01 2007

Attorney Docket No. 10240/2

**REMARKS/ARGUMENTS****Substitute Drawings**

In compliance with 37 C.F.R. §1.121(d), Applicants submit herewith substitute drawings. The drawings have been amended to eradicate the text previously contained therein as required by Examiner. The text has been appropriately incorporated into the specification, as provided below. No new matter has been added to the drawings.

**Substitute Specification**

In accordance with the requirements of 37 C.F.R. §1.125(b) and (c), Applicants submit herewith a substitute specification, including both clean and marked up versions. The specification has been amended to incorporate the text extracted from the drawing pages, as required by Examiner, into the appropriate paragraphs of the specification, with the addition of only generic introductory language.

Additionally, in compliance with 37 C.F.R. §1.74, the section entitled "Brief Description" of the Drawings has been provided. The text of this section utilizes language previously existing in the application and drawings.

No new matter has been added to the specification.

**Amendment of the Claims**

Upon entry of the claim amendments, Claims 51-53, 56, 57, 59-71, 74, 75, 77-92 will be all the claims pending in the application.

Claims 1-50 were previously canceled.

Claims 54, 55, 58, 72, 73 and 76 are canceled herein.

Independent claims 51 and 69 have been amended pursuant to 37 C.F.R. §1.116(b) to more clearly delineate the patentable features of the present invention and to present the claims in better form for consideration on appeal. Specifically, independent claim 51 has been amended to include the limitations of claims 54, 55 and 58, and independent claim 69 has been amended to include the limitations of claims 72, 73 and 76. Additionally, claims 56, 57, 59, 68, 75, 75 and 77 have been amended to correct dependency based on the claim cancellations and amendments listed above.

No new matter has been added.

USSN: 09/992,345

10 of 14

February 7, 2007

K:\Hpc\LA\Prosecution\Films Prosecution\10240-2 - (613,321)\US\10240-2-US-2007Feb07-RESPONSE TO FINAL REJ.DOC

In response to Examiner's comments regarding the use of the term "packaging product design", Applicants are not seeking patent protection for adhesives, supplier names, packaging types and other more specific elements. Rather, the term "packaging product design" is one of the "digital data" recited in step (a) of claim 51.

As used in the specification, the term "Packaging Product Design" is defined as "the combination of the Packaging Design with the structure of the package, which includes at least some of the materials used to make the package." (emphasis added). (See paragraph [0075] of the substitute specification / page 4, lines 31-33 of the application as filed).

The Packaging Design element of the Packaging Product Design is defined as "the graphic design (image) displayed on a package" (paragraph [0075] of the substitute specification / page 4 lines 30-31 of the application as filed. See also Figure 8A).

Examples of the "structure of the package" are denoted in Figure 8D and Figure 10B. These drawings exemplify packages wherein the structure of the package includes, but is not limited to, two layers of film substrates, a print layer and a layer of adhesive. The digital data representing these structural elements are entered into the digital computer system for processing and analysis by the digital computer system.

As a further non-limiting example, the "materials used to make the package" is defined in paragraph [0082] of the substitute specification / page 7, lines 8-9 of the application as filed as "materials such as plastic film."

Therefore, as demonstrated above, the Packaging Product Design is digital information formed from the combination of (1) data about the graphic design (image) to be displayed on a packaging item and (2) data designating at least one of the physical components or materials used to make the packaging item, such as plastic film.

#### **Rejection Under 35 U.S.C. § 102(b)**

At section 2, page 3 of the Action, claims 51, 54-64, 67, 69, 72-82, 85, 91 and 92 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,167,382 to Sparks *et al.* Applicants respectfully traverse this rejection.

Sparks *et al.* was filed on June 1, 1998, prior to the effective date of the USPTO pre-grant publication procedure. Therefore, the date upon which Sparks *et al.* is available as prior art under 102(b) is December 26, 2000, the date of issuance thereof. The current application properly claims priority to provisional U.S. application 60/251,488, filed on December 5, 2000, and as such, predates the available reference date of Sparks *et al.* under 102(b).

USSN: 09/992,345

11 of 14

February 7, 2007

K:\Hpel\AWP\Prosecution\Films Prosecution\10240-2 - (813,221)\US\10240-2-US-2007Feb07-RESPONSE TO FINAL REJ.DOC

However, Applicants believe the Examiner intended to base this rejection on 35 U.S.C. § 102(e)(2). Such rejection has been rendered moot by the claims amendments submitted herewith.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. Richardson vs. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Sparks *et al.* fail to disclose, either expressly or inherently, the processing of digital data representing a packaging product design, wherein the packaging product design comprises both the graphic design (image) to be displayed on a packaging item and the structure of the package, which includes at least one of the materials used to make or physically construct the packaging item, as discussed in the section above and required by the amended claims. Further, Sparks *et al.* fail to disclose the creation and use of metadata, as required by the amended claims.

For these reasons, Applicants respectfully request that the Examiner reconsider and withdraw this §102 rejection.

#### Rejections Under 35 U.S.C. § 103(a)

At section 1, page 4 of the Action, claims 52, 53, 65, 66, 68, 70, 71, 84, 84 and 86 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,167,382 to Sparks *et al.* in view of "Flexible Modeling and Execution of Workflow Activities" by Weske.

This rejection has been rendered moot by the submission of amended independent claims 51 and 69.

The claims of the present invention, as amended herein, require the processing of digital data representing a packaging design with a digital computer system to create metadata. The creation and use of metadata is an integral part of Applicants invention - "a new class of metadata must be created." (See paragraph [00103] in the substitute specification / page 12, line 31 in the application as filed). Applicants disclosure "satisfies this requirement by defining specific metadata elements, providing algorithms to extract these elements from an image, and incorporating the use of these elements into its enabling computer system." (Also, paragraph [00103] in the substitute specification / page 12, line 32

USSN: 09/992,345

12 of 14

February 7, 2007

K:\Rpt\LA\Prosecution\Films Prosecution\10240-2 - (813,221)\US\10240-2-US-2007Feb07-RESPONSE TO FINAL REJ.DOC

through page 13, line 3 of the specification as filed). Paragraphs [00104] through [00115] of the substitute specification (page 13, line 9 through page 16, line 7 of the specification as filed) set forth in detail each of the metadata elements of the present invention including "Printing Colors", "Ink Coverage", "Process Difficulty", "Bounce" and "Image Dimension".

Next, Examiner contends that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to use the manufacturing simulation concepts set forth in the Weske paper to determine if the supply chain of Sparks was able to produce the packaging item ordered in the specified quantity on the specified date because built-to-order manufacturing supply chains provide the benefits of reduce production costs and efficient utilization of resources."

Applicants submit that Weske teaches that data such as "the sub-parts of P have to be determined, including their respective sub-parts", "the local manufacturing capacities are analyzed and a time slot for the (potential) production of the complex product is reserved" and finally, "the date of potential shipping is calculated." [emphasis added] However, nothing in Weske teaches the method by which these determinations, analyses, reservations and calculations are to be made. Further, nothing in Weske teaches nor suggests use of metadata "to return a digital output having the information required to fulfill said packaging order" as required by the amended claims.

For these reasons, persons skilled in the art would not look to Weske, or a combination of Sparks *et al.* and Weske, for guidance on how to create the method and computer system of the current invention.

#### Second Rejection Under 35 U.S.C. § 103(a)

At section 6, page 5 of the Action, claims 87-90 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,167,382 to Sparks *et al.* in view of "Flexible Modeling and Execution of Workflow Activities" by Weske and further in view of U.S. Patent No. 6,415,196 to Crampton *et al.*

This rejection has been rendered moot by the submission of amended independent claims 51 and 69.

As with Sparks *et al.* and Weske, discussed above, Crampton *et al.* do not teach nor suggest the use of metadata to return a digital output having the information required to fulfill a packaging order as required by the amended claims.

Attorney Docket No. 10240/2

For the reasons stated above with respect to Crampton *et al.*, and the previous discussion regarding Sparks *et al.* and Weske, Applicants respectfully submit that the current invention is not disclosed, taught or suggested by Sparks *et al.* in view of Weske and in further view of Crampton *et al.*

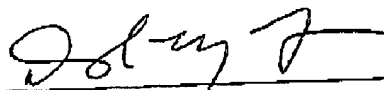
For the foregoing reasons, Applicants respectfully request the withdrawal of the §103 rejections.

This application is now believed to be in order, and reconsideration and allowance are hereby solicited. If any points remain in issue which Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

February 7, 2007

Date



Darryl M. Tyus  
Attorney for Applicants  
Registration No. 40,853

ExxonMobil Chemical Co.  
Law Technology  
P.O. Box 2149  
Baytown, Texas 77522-2149  
Phone: 281-834-2581  
Fax: 281-834-2495

USSN: 09/992,345

14 of 14

February 7, 2007

K:\Bp\LA\Prosecution\Films Prosecution\10240-2 - (813,231)\US\10240-2-US-2007Feb07-RESPONSE TO FINAL REJ.DOC

BEST AVAILABLE COPY